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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,495

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Alistair Oakes

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EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3725

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,495	Applicant(s) OAKES, ALISTAIR	
	Examiner PRADEEP C. BATTULA	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This reply to the response filed on May 22, 2008

Claim Objections

Claims 1 – 24 are objected to because of the following informalities: In Claim 1 delete the first word "Identification" and please insert --An identification-- as the first two words. In Claims 2 – 22, please delete the first word "Identification" in every claim and please insert --The identification-- as the first two words. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support of a fourth removable portion and only provides support for three (Paragraphs 0028, 0049, 0053).

Claims 8 – 14, and 22 are further rejected since they depend from Claim 7.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 – 14 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The third and fourth removable portions are never discussed together and it is not clear if there are third and fourth removable portions.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is only providing an indication that the second identification is printed in a non-simultaneous manner with the first identification, however, the term “substantially simultaneous” does not provide any kind of boundary since there is no standard for time.

Claim Rejections - 35 USC § 102

1. Claims 1 – 6, 15, 18 – 20, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein et al. (U.S. 3,055,117).

In regards to Claims 1 and 23, Bernstein a identification means (Column 1, Lines 12 – 21), said identification means including a first identification portion 11 relating to data of a secure or confidential nature in the form of one or more images, characters and/or text (Column 4, Lines 30 – 34; Figure 1, Item 11), a second identification portion [shown in portions 12 – 16] removably located directly on top of with at least a part of said first identification portion to at least partially mask the first identification portion (Column 4, Lines 34 – 43; Figure 1, Items 12 - 16) until said second identification portion has been removed therefrom (Column 3, Lines 66 – 75 → Column 4, Lines 1 –

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12), said second identification portion also being in the form of one or more images, characters and/or text (Column 4, Lines 34 – 43), and wherein the second identification portion is provided in overlapping relationship on said first identification portion (Column 3, Lines 66 – 71) so that the combination of the first and second identification portions forms a further one or more images, characters and/or text different in appearance to said first and second identification portions, the first and second identification portions being undecipherable from the further one or more images, characters and/or text until the second identification portion has been removed (Column 3, Lines 60 – 65; Column 4, Lines 5 – 12; removable ink and portions of the information are exposed but both patterns form a solid design where one cannot discern the gaps in the removable ink from the information as they all look like one long patterned strip (Figure 1, Items 12 - 16) and wherein at least one further removable portion or coating is applied over at least a part of said first and second overlapping identification portions (Column 4, Lines 13 – 20; an additional opaque ink layer can be combined with the concealing layers of 12 - 16).

In regards to Claim 2, Bernstein further discloses wherein the second identification portion is formed from an abradable material which is irreversibly removable from the first identification portion (Column 3, Lines 75 → Column 4, Lines 1 – 3).

In regards to Claim 3, Bernstein further discloses wherein the second identification portion is located with a whole or substantial part of said first identification portion (Column 3, Lines 8 – 15; Column 4, Lines 34 – 43).

In regards to Claim 4, Bernstein further discloses wherein the second identification portion is provided under or below the first identification portion (Column 3, Lines 71 – 75).

In regards to Claim 5, Bernstein further discloses wherein the second identification portion is provided on top of or above the first identification portion (Column 4, Lines 66 – 71).

In regards to Claim 6, Bernstein further discloses wherein the second identification portion is different in appearance to the first identification portion (Column 4, Lines 7 – 12; 30 – 43; Figure 1, Items 11 – 16).

In regards to Claim 15, Bernstein further discloses wherein the identification means are any of a carrier, telephone card, promotional game, ticket, pin card, label, scratch card, brand protection process or lottery ticket (Column 3, Lines 66 – 75 → Column 4, Lines 1 – 12; As previously cited Bernstein has scratch off ink in several areas that is meant to be scratched off and any carrier having scratch off material can be considered a scratch card).

In regards to Claim 18, Bernstein further discloses wherein the first identification portion is printed onto the identification means (Column 2, Lines 24 – 27; Column 4, Lines 57 – 75).

In regards to Claim 19, Bernstein further discloses wherein a holographic image is provided on said identification means (Column 3, Lines 19 – 24; diffractive patterns are possible in the concealing areas and diffracting patterns are specifically used create holographic images).

In regards to Claim 20, Bernstein further discloses wherein the first identification portion includes a resin containing material (Column 2, Lines 24 – 27; Column 4, Lines 57 - 75; teaches that the first identification is printed which inherently is done by ink and it is very well known that inks are provided with resins).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7 – 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al. (Bernstein; U.S. 3,055,117) in view of Griffin et al. (Griffin; U.S. 5,154,448).

In regards to Claim 7, Bernstein does not disclose wherein at least one removable portion or coating is applied over at least a part of said first and second identification portions.

Griffin teaches of providing a scratch off material 60 which is removable by a user to enable the user to create indicia (Column 2, Lines 35 – 44) and the scratch off material is capable of being removed very easily such as by using a fingernail to create indicia (Column 2, Lines 35 - 44; Figure 2). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the scratch off coating of Griffin in order to provide informative, identifying, or directive indicia regarding the concealed indicia of Bernstein (Column 1, Lines 11 – 16).

In regards to Claims 8, Bernstein modified by Griffin further discloses wherein the at least one further removable portion or coating is applied to a whole of substantial part of said first and second identification portions (Column 3, Lines 8 – 15; Column 4, Lines 7 – 12, 34 – 43 of Bernstein teaches that the coatings are meant to cover a whole of substantial part of said first and second identification and therefore any coating provided on Bernstein would need to cover a whole of a substantial part of the identification portions).

In regards to Claims 9, Bernstein modified by Griffin further discloses wherein the further removable portion includes one or more layers of abradable material (Column 2, Lines 39 – 44; Griffin).

In regards to Claims 10, Bernstein modified by Griffin further discloses wherein at least a third identification portion is provided on the further removable portion (Column 2, Lines 35 - 44; Figure 2; Griffin teaches that indicia is placed in the layer and this creates an identification).

In regards to Claims 11, Bernstein modified by Griffin further discloses wherein the third identification portion is visible to a user viewing the identification means (Figure 2 of Griffin; the gaps are in the scratch off layer and in combination with Bernstein, Griffin's scratch off layer would be the top layer of the identification means and would therefore have the indicia visible).

In regards to Claims 12, Bernstein modified by Griffin further discloses wherein the third identification portion relates to or is associated with one or more images, characters and/or text provided on the identification means (Figure 2; Griffin).

In regards to Claims 13, Bernstein modified by Griffin further discloses wherein the one or more images, characters and/or text are separate to and/or independent of said first and/or second identification portions (Column 1, Lines 11 – 16 of Griffin teaches that the layer is known to convey information and is therefore fully capable of being different from the first and second identifications; Figure 2; Griffin).

In regards to Claims 14, Bernstein modified by Griffin further discloses wherein the third identification portion is formed from abradable material (Column 2, Lines 35 – 44; Griffin).

In regards to Claims 22, Bernstein modified by Griffin further discloses the further removable portion includes a wax containing material (Column 2, Lines 35 – 39; Griffin).

3. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein in view of Raymond (WO 99/56270).

In regards to Claims 16 and 17, Bernstein does not disclose wherein the identification means is provided with attachment means for attaching the same to an article wherein the attachment means includes an adhesive provided thereon.

Raymond teaches of an identification means having a first identification covered by a second identification which is of an abradable material 5 (Page 5, Lines 33 – 38; Figure 3, Item 5) wherein the identification means has a rebondable adhesive (Page 2, Lines 32 – 38 → Page 3, Lines 1 – 16). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the identification means of Bernstein with an adhesive on one side of the ticket in order to

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allow for the ticket to be applied to different objects and prevent loss (Page 3, Lines 4 – 14).

4. Claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein in view of Itakura et al. (Itakura; U.S. Publication 2003/0104174 A1).

In regards to Claim 21, Bernstein discloses that the second identification portion is advantageously a removable ink but it is not required to be a removable ink since it is only advantageous (Column 4, Lines 7 – 12).

Bernstein does not disclose wherein the second identification portion includes a resin and wax.

Itakura teaches that it is very well known in the art that concealing layers, for concealing printed matter, can be comprised of rupturable layers comprised of resins and waxes (Paragraph 0005). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the concealing layer of Bernstein with such materials in order to provide a known alternative which provides the same result.

5. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein.

In regards to Claim 24, Bernstein does not explicitly disclose wherein the first and second identification portions are applied to the identification means substantially simultaneously during manufacture, however, the term is indefinite (as previously discussed) and Bernstein does disclose that the Identification means can be produced by known graphic art methods (Column 2, Lines 24 - 27) and it is also important to note that Bernstein does not have to be used for concealing answer information but can be

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used to conceal any information (Column 1, Lines 12 – 20). The Examiner takes Official Notice that it is well known in the graphic arts to produce two printed patterns of different material in very close intervals. It would have been obvious to do so in Bernstein in order to prevent any kind of early detection or revealing of the information to be concealed.

Response to Arguments

Applicant's arguments with respect to claims 1 - 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
September 23, 2008

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725